REMARKS

It is noted that the claim amendments herein are intended solely to more particularly point out the present invention for the Examiner, and <u>not</u> for distinguishing over the prior art or the statutory requirements directed to patentability.

It is further noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-12 are all of the claims pending in the present Application. New claims 11 and 12 have been added. Claims 1-10 stand rejected under 35 USC §112, second paragraph, as being indefinite. Claims 1, 4, 5, and 7-10 stand rejected under 35 USC §102(e) as anticipated by US Patent 6,240,411 to Thearing. Claims 2, 3, and 6 stand rejected under 35 USC §103(a) as unpatentable over Thearing, further in view of a description that the Examiner alleges to be Applicants' Admitted Prior Art (APA).

These rejections are respectfully traversed in view of the following discussion.

I. THE CLAIMED INVENTION

As described and claimed, for example by claim 1, the present invention addresses a computer method that provides a department store space-requirements database comprising a compendium of individual department store space-requirements history. A department store space-availability database is also provided, comprising a compendium of at least one of department store space management solutions, department store space information, and department store space diagnostics. A data mining technique interrogates the department store space-requirements and department store space-availability databases and generates an output data stream that correlates the department store space-requirements problem with department store space-availability solution.

II. THE 35 USC §112, SECOND PARAGRAPH, REJECTION

Claims 1-10 are understood as being rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant respectfully traverses this rejection.

The Examiner asserts:

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"The term individual department store space-requirements history in claims 1 and 9-10 is used by the claim to mean the records of a specific item in a database of a store as an example of individual department store space-requirements history in the specification, page 9, line 20-page 10, line 2, while the accepted meaning is "the records of the space requirement of an individual department store". The term is indefinite because the specification does not clearly redefine the term."

In response, Applicants point out that the Examiner seems confused, as follows.

First, Applicants do not intend a definition that differs from that of the plain language meaning of the words: "individual department store space-requirements history". The Examiner seems to understand this plain language meaning.

Second, the description beginning at line 20 of page 9 through line 2 of page 10 applies to "features", not to "individual department store space-requirements history", as the Examiner seems to assert. Therefore, the Examiner is incorrect in asserting that the description on pages 9 and 10 of "features" somehow implies that the plain meaning of the phrase "individual department store space-requirements history" would be construed by one of ordinary skill in the art as requiring a redefinition.

In view of the foregoing clarification, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE PRIOR ART REJECTION

The Examiner alleges that US Patent 6,240,411 to Thearling anticipates claims 1, 4, 5, and 7-10 and, when combined with APA, renders obvious claims 2, 3, and 6.

Applicants disagree.

First, it is pointed out that Thearling address a campaign manager, which is not in any way related to the present problem of resolving problems in a department store space-requirements. The Examiner is understood as conceding this description of Thearling in the sentence on page 3 of the Office Action:

"Regarding to claims 1, 9, and 10, Thearling teaches a method, a computer program, and a computer for incorporating references to data mining models into the underline campaign management process. As shown in FIG. 12, a data warehouse or database 125 is coupled directly to the data-mining engine 124 (Col. 15, lines 6). The data warehouse 125 stores the records of the customers who involved with a business transaction in the past and subjected to a marketing campaign as in FIG. 1A (Col. 1, lines 18-50)." (Emphasis by Applicants)

Applicants submit that one of ordinary skill in the art would not at all associate the above description by the Examiner as being in any way related to a problem in department store space-requirements, as the Examiner further mysteriously alleges in the following line:

"Thus, the database 125 as a department store space-requirements database with the records of the customers who involved in a transaction of business in the past as a compendium of individual department store space-requirements history is provided to the data-mining engine."

That is, there is no suggestion whatsoever in Thearling to apply the data-mining techniques discussed therein in the environment of the present invention (e.g., department store space-requirements).

Second, even if, *arguendo,* Thearling did address department store space-requirements, as alleged by the Examiner, it would still not teach, suggest, or even hint at the technique of the present invention, as described by the independent claims.

That is, as described in the specification and defined in the independent claims, the present invention uses two databases, a first database for department store space-requirements and a second database having at least one of department store space management solutions, department store space information, and department store space diagnostics.

Although one of ordinary skill in the art would readily understand that the two databases could actually be combined into a common memory so as to arguably form a single database, the terminology of the present invention is intended to mean that there are two types of data being analyzed by the data mining engine (e.g., data for space-requirements and data for solutions).

The present invention includes the technique of correlating the two types of data (e.g., the two databases) in order to find solutions for space-requirement problems.

In contrast, Thearling includes only a single database (e.g., a single type of data) and does not perform any correlation to search for solutions. Indeed, there is no correlation step at all in Thearling. The Examiner attempts to rely on the APA as demonstrating updates of a database, but, even if the Examiner's interpretation of the law were correct, this demonstration would not overcome the deficiencies identified above for Thearling.

Hence, turning to the clear language of the claims, there is no teaching or suggestion of "... i) providing a <u>department store space-requirements database</u> comprising a compendium of individual department store <u>space-requirements</u> history; ii) providing a <u>department store space-availability database</u> comprising a compendium of at least one of <u>department store space management solutions, department store space information, and department store space diagnostics</u>; and iii) employing a data mining technique for interrogating said department store space-requirements and department store space-availability databases for generating an output data stream, said output data stream <u>correlating department store space-requirements problem with department store space-availability solution</u>", as required by the independent claims.

Moreover, relative to the Examiner's characterization that the terminology at lines 1-3 of page 9 (e.g., "a conventional technique can be used to this end") as being admitted prior art, Applicants traverse that this description, clearly not at all included in a section of the specification describing the prior art, can be described as admitted prior art.

That is the existence of "conventional techniques" does not at all provide justification that it would have been obvious at the time of the invention to apply the "conventional techniques" into a totally different environment, such as described in Thearling. Therefore, Applicants submit that the rejection currently of record errs as a matter of law for at least two reasons.

First, it is error to allege that the description at lines 1-3 of page 9 is Applicants' admitted prior art. Second, the rejection fails to include a proper motivation to combine this phrase with the primary reference Thearling.

For the reasons stated above, the claimed invention is fully patentable over the cited references.

Further, the other prior art of record has been reviewed, but it too, even in combination with Thearling, fails to teach or suggest the claimed invention.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-12, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in
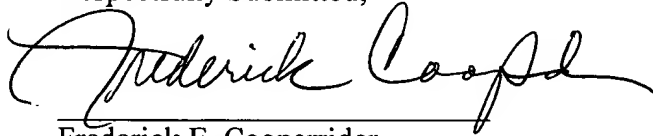
condition for allowance. The Examiner is respectfully requested to pass the above
application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance,
the Examiner is requested to contact the undersigned at the local telephone number listed
below to discuss any other changes deemed necessary in a telephonic or personal interview.
The Commissioner is hereby authorized to charge any deficiency in fees or to credit any
overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: 10/30/03

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